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REMARKS

Claims 90-106 are pending in the instant application.

Claims 90-106 stand rejected in the instant application.

Applicant notes with appreciation the withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, and the rejections under 35 U.S.C. § 103(a).

Assignee's Ownership Interest under 37 C.F.R. 1.175(b)/

Assignee's Assent under 37 C.F.R. 3.73:

The Examiner has objected to the application under 37 C.F.R. § 1.175(b) on the basis that Applicant has not established its ownership interest in the patent for which reissue is being requested.

Applicant previously submitted the "Assignees Assent to Filing Reissue Pursuant to 37 C.F.R. § 1.175 and Offer to Surrender Original Letters Patent Pursuant to 37 C.F.R. § 1.178", which was signed by Mark F. Wachter, Esq. on behalf of current assignee Solutia Inc. and filed on February 23, 1999 in the earlier reissue application serial no. 08/966,425 (a copy of which was previously provided as **Exhibit B**). Applicant further previously submitted a document, identified as **Exhibit C**, which demonstrated that Mark F. Wachter had authority to act on behalf of current assignee Solutia Inc.

Applicant respectfully further submitted that this previously filed paper addressed the question of change in ownership from Monsanto Company to Solutia Inc. and satisfied the requirements of 37 C.F.R. § 3.73. As such, Applicant respectfully requests that the Examiner's objection under 37 C.F.R. § 1.175(b) be withdrawn.

Oath/Declaration:

The Examiner has rejected claims 90-104 as being based upon a defective oath/declaration under 37 C.F.R. § 1.175(b).

A revised declaration was filed on February 19, 1999 as Exhibit J to the amendment in response to the August 19, 1998 Office Action in the merged reexamination/reissue proceeding of the earlier reissue application serial no. 08/966,425 and claims 90-104 in the present reissue application correspond to claims 120-134 in the prior merged reexamination/reissue application. A copy of the revised declaration was previously provided.

Applicant respectfully submits that the previously filed revised declaration meets the requirements of 37 C.F.R. 1.175(b)(1). As such, Applicant respectfully requests that this rejection be withdrawn.

Recapture Rejection under 35 U.S.C. § 251:

Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 90-104 under 35 U.S.C. 251 for allegedly being improperly broadened in the reissue application (Office Action dated January 24, 2002, pp. 4-5). The Examiner stated that “[a]pplicant originally claimed a trialkyl phosphate in which the alkyl substituents are substantially C₄ or C₅. Applicant then filed an amendment that limited the trialkyl phosphate to an isoalkyl C₄ or C₅ that is bonded to the phosphate moiety via a primary carbon atom (see Applicant’s amendment filed 6-30-94), to overcome the prior art of record.” The Examiner stated that it appears that Applicant is allegedly attempting to recapture subject matter which was surrendered during prosecution in 08/099,267 (“the ‘267 application”) in order to obtain a patent, noting the amendments made to the claims on June 30, 1994 in response to the Office Action of March 8, 1994.

Applicant respectfully traverses this rejection and maintains that claims 90-104 (“the reissue claims”) were not added in an attempt to recapture subject matter that was surrendered in the ‘267 application but represent an invention that was disclosed but, mistakenly, not claimed in the original application. As explained in the Declarations of Gerbrand Deetman and Wendell Brooks, dated November 4, 1997 and November 7,

1997, respectively, which were previously provided in the last response papers, that failure to claim occurred without deceptive intent.

The court in In re Clement, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997) explained that the “recapture rule” exists to prevent “a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” 45 U.S.P.Q. 2d at 1164. The rule requires that the claims be analyzed first to determine if they are broader in any material aspect and, if so, to determine if the broader aspect relates to surrendered subject matter. Id. The court recognized, however, that situations may exist where the reissue claims may be broader in some aspects and narrower in other aspects when compared to the prior claims. 45 U.S.P.Q. 2d at 1165. In such instances, the court explained, the claims must be analyzed to determine whether both the narrower and broader aspects of the claim are relevant to prior art rejections to determine whether the claims violate the recapture rule, focusing on whether the patentee was “attempting to recapture surrendered subject matter.” Id. The court then outlined a test, which is reproduced in the M.P.E.P. at §1412.02. That section of the M.P.E.P. further instructs that “if the narrowing limitation has a material aspect to it, then there is no recapture.”

Because of the facts in this application, however, the test outlined in Clement and reproduced in the M.P.E.P. does not complete the analysis. As the C.C.P.A. noted in In re Richman, 161 U.S.P.Q. 359 (C.C.P.A. 1969) attention must also be directed to the original claims and the amendments made during the prosecution of the patent to determine whether those amendments were necessary to secure allowance over the prior art. 161 U.S.P.Q. at 363. As the court in Richman reasoned,

certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same features or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

Id. The court stated that the recapture rule did not prevent an Applicant from broadening a limitation added to a claim in obtaining its allowance, “if the limitation turns out to be more restrictive than the prior art required.” Id.

Applicant maintains that the reissue claims (claims 90-104) require analysis under both tests. The content of the phosphate ester base stock and the combination of

additives were both directly relevant to the rejections overcome in the prosecution of the '551 patent. As noted by the Examiner, in relation to all of the issued claims, the reissue claims are broader with respect to the definition of the phosphate ester base stock. However, it is clear that the reissue claims are narrower than independent claims 1, 19, 31, 50, 56, and 67 of the '551 patent and the claims dependent thereon with respect to the definition of the additive package, which is a material aspect. Therefore, the recapture rule, as outlined in Clement and explained in M.P.E.P. 1412.02, does not bar the reissue claims with respect to independent claims 1, 19, 31, 50, 56, and 67.

Applicant acknowledges that in relation to the remaining independent claims 7, 8, 11 and 78 of the '551 patent, the claims in the instant application are not narrower with respect to the additive package. Yet, this does not automatically bar claims 90-104 under the recapture rule because, under the test in Richman, the broadening with respect to the base stock in the reissue claims is not recapture of surrendered subject matter. As explained more fully below, the limitation added to claims 7, 8, 11, and 78 defining the base stock as substantially C₄ or C₅ isoalkyl phosphate esters was not necessary to distinguish these claims over the art.

The claims that issued in the subject patent are all directed to fluid compositions that contain mixtures of phosphate esters, namely trialkyl-, alkyl diaryl-, dialkyl aryl-, and triaryl-phosphate esters, as base stock for the compositions. In particular, the alkyl substituents in these phosphate esters were specified as being substantially C₄ or C₅ isoalkyl substituents that are bonded to the phosphate moiety through a primary carbon. The '551 patent discloses this aspect as one of the features of the invention. (See, for example, Col. 12, line 7, through Col. 13, line 21). As Applicant noted in the present reissue application papers, the new claims are directed to subject matter that was disclosed in the application but, mistakenly, not claimed and not surrendered during prosecution of the original patent.

Only two office actions were issued during the prosecution of the subject patent, an Office Action dated January 29, 1993 in parent application serial no. 07/897,189, and an Office Action dated March 8, 1994 in continuation-in-part application serial no.08/099,267. In each office action, the claims were rejected as anticipated under 35 U.S.C. 102 or obvious under 35 U.S.C. 103 in view of various combinations of the

following patents: MacKinnon, U.S. Patent No. 4,206,067; MacKinnon, U.S. Patent No. 4,324,674; MacKinnon, U.S. Patent No. 5,035,824; Farng et al., U.S. Patent No. 5,037,567; Chesluk et al., U.S. Patent No. 3,931,022; and Ryan et al. 4,868,023. The rejections pointed not only to the phosphate ester base stock components disclosed in these references but also to the additives disclosed.

As a response to the Office Action dated January 29, 1993, Applicant chose to refile the application on July 28, 1993 as a continuation-in-part and included a Preliminary Amendment which clarified some specification and claim language from the original application, added new claims and added additional experimental data to the specification. The next office action was issued March 8, 1994 as the first action in the continuation-in-part application. The Office Action dated March 8, 1994 did not repeat all of the rejections from the Office Action dated January 29, 1993 but it did contain the same substantive rejections over the art based on both the phosphate ester base stock components and the additives disclosed in the art.

In response to the Office Action dated March 8, 1994, Applicant filed an Amendment on June 28, 1994 which cancelled some claims and amended the remaining claims to limit the phosphate ester base stock component of the claimed fluid compositions to the preferred embodiment, namely those phosphate esters that contained substantially C₄ or C₅ isoalkyl substituents. Applicant also emphasized that the references cited did not teach or suggest the use of substantially C₄ or C₅ isoalkyl substituents on phosphate ester base stocks and therefore the invention claimed was not anticipated nor rendered *prima facie* obvious by the references. (See, for example, Amendment dated June 28, 1994, pages 27-30). No further Office Actions were issued and no further amendments were made prior to the issuance of the '551 patent.

Importantly, although the combination of additives used in the claimed functional fluid composition was pertinent to the rejections over the art, Applicant did not properly argue the patentability of the claims based on the combination of the novel additive package with originally claimed base stocks. The combination of additives in Applicant's novel additive package is not suggested or obvious in view of the art of record in the prior prosecution or of record in this reissue application Office Action. Thus, although claims 7, 8, 11, and 78 were patentable over the art without the limitation

of substantially C₄ or C₅ isoalkyl phosphate ester base stocks, Applicant mistakenly chose to amend the claims to recite this limitation. Applicant did not concede the subject matter of reissue claims 90-104 during prosecution because the amendments made to claims 7, 8, 11, and 78 to recite substantially C₄ or C₅ isoalkyl base stock material were more restrictive than was necessary to overcome the cited art. It is clear that prior to this amendment, these claims were distinguishable over the cited art based on the additive composition that was neither taught nor suggested by the art. Similarly, reissue claims 90-104 are not anticipated or rendered obvious by the art of record because they also recite the novel additive package while more broadly reciting Applicant's mistakenly unclaimed inventive compositions comprising the novel additive package in combination with all known fire resistant phosphate ester base stock compositions. Therefore, the recapture rule as further defined in Richman does not bar reissue claims 90-104 with respect to claims 7, 8, 11, and 78.

Applicant respectfully submits that the above remarks on the 35 U.S.C. § 251 rejection also apply to claims 105 and 106.

Accordingly, Applicant respectfully requests examination of claims 90-106 and, for the reasons given, respectfully requests reconsideration and withdrawal of the rejection of claims 90 and 104 under 35 U.S.C. § 251.

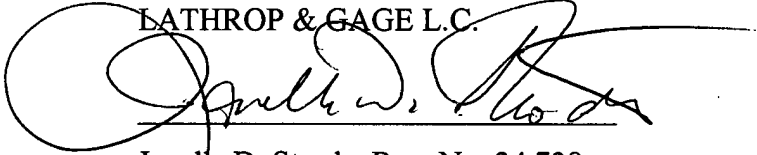
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Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to call Applicants' undersigned attorney in an effort to resolve such issues and advance this application to issue.

Respectfully submitted,

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